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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,803	07/07/2004	Tachio Ono	03500.016946.	8287
5514 7590 06/23/2009 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
BEMBEN, RICHARD M				
ART UNIT		PAPER NUMBER		
2622				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/500,803

Applicant(s)

ONO, TACHIO

Examiner

RICHARD M. BEMBEN

Art Unit

2622

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-15 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-15 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6 June 2009 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claim 11 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 11-15 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub. No. 2002/0108118 A1 filed by Cohen et al., hereinafter**

“Cohen”, in view of US Patent No. 6,356,813 B1 issued to Sommer et al., hereinafter “Sommer”.

Note regarding apparatus claims: “While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. >In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). [...] A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was “for mixing flowing developer material” and the body of the claim recited “means for mixing ..., said mixing means being stationary and completely submerged in the developer material”. The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board

held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.)" See MPEP 2114.

Regarding **claim 11**, Cohen discloses a storage apparatus (refer to [0039]-[0059] and Figures 3A-C) comprising:

a first interface unit for connection to a first external apparatus, said first interface unit having a first port to which the first external apparatus is connectable and disconnectable and through which said first interface unit connects to the first external apparatus ([0042] and Figures 3A-C, "120a,b" and/or [0044] and Figures 3A-C, "122a,b");

a second interface unit for connection to a second external apparatus, said second interface unit having a second port to which the second external apparatus is connectable and disconnectable and through which said second interface unit connects to the second external apparatus ([0042] and Figures 3A-C, "120a,b" and/or [0044] and Figures 3A-C, "122a,b");

a third interface unit for connection to a removable storage medium ([0011], [0048]-[0050], inherent that there is an interface the storage medium); and

a control unit that controls the first port and the second port ([0040], [0045]-[0047] and Figures 3A-C, "110") and sets the first port or the second port in a disabled state ([0068]-[0069], [0074] - "if they are unable to provide the necessary information, the link typically will be severed...").

Cohen further discloses manual switches that provide input commands to the control unit to control data transmission ([0046]).

However, Cohen does not explicitly disclose that if said first interface unit detects that the first external apparatus is connected to the first port, said control unit determines whether the first external apparatus is capable of accessing the removable storage medium connected to said third interface unit,

if said second interface unit detects that the second external apparatus is connected to the second port, said control unit determines whether the second external apparatus is capable of accessing the removable storage medium connected to said third interface unit,

wherein said control unit does not set the second port in the disabled state until said control unit determines that the first external apparatus connected to the first port is capable of accessing the removable storage medium connected to said third interface unit; and

wherein said control unit does not set the first port in the disabled state until control unit determines that the second external apparatus connected to the second port is capable of accessing the removable storage medium connected to said third interface unit.

Sommer discloses a storage apparatus comprising first and second ports (with respective interfaces) and a control unit (Figure 1) wherein if said first interface unit detects that the first external apparatus is connected to the first port, said control unit determines whether the first external apparatus is capable of accessing the removable

storage medium connected to said third interface unit, if said second interface unit detects that the second external apparatus is connected to the second port, said control unit determines whether the second external apparatus is capable of accessing the removable storage medium connected to said third interface unit, wherein said control unit does not set the second port in the disabled state until said control unit determines that the first external apparatus connected to the first port is capable of accessing the removable storage medium connected to said third interface unit; and wherein said control unit does not set the first port in the disabled state until control unit determines that the second external apparatus connected to the second port is capable of accessing the removable storage medium connected to said third interface unit (c. 1, l. 40 – c. 2, l. 35 and c. 4, ll. 14-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention to control memory access as disclosed by Sommer in the storage apparatus disclosed by Cohen because, in a storage apparatus that can be accessed by plural devices, it is necessary to monitor memory access and sometimes disable certain external devices such that the memory that is being downloaded (read from memory) by one external device is not corrupted (written to memory) by another external device.

Regarding **claim 12**, refer to the rejection of claim 11 and Cohen further discloses that if the first port is set in the disabled state, the first port can not electrically connect to the first external apparatus, and wherein if the second port is set in the disabled state, the second port can not electrically connect to the second external

apparatus ([0068]-[0069], [0074] - "if they are unable to provide the necessary information, the link typically will be severed...").

Regarding **claim 13**, refer to the rejection of claim 11 and Cohen further discloses that said first interface unit conforms to an IEEE 1394-1995 or an IEEEa-2000 standard ([0042]).

Regarding **claim 14**, refer to the rejection of claim 11 and Cohen further discloses that said second interface conforms to a USB 1.1 standard or a USB 2.0 standard ([0042]).

Regarding **claim 15**, Cohen discloses the storage apparatus required by claim 11. Cohen further discloses using the storage apparatus with "a digital camera, digital camcorder or other image/video capture device" ([0002]). It would have been obvious to one of ordinary skill in the art to make the storage apparatus an integral part of a digital video camera. The storage apparatus disclosed by Cohen reduces the amount of memory required in a digital video camera and thus increases the camera's portability ([0010]-[0014]). However, there are many situations, where a digital video camera is not required to be portable, such as a stationary television camera. In these situations, it would be obvious to combine the storage apparatus and the digital video camera into one device.

Regarding **claim 21**, refer to the rejection of claim 11 and Cohen further discloses that if said first interface unit receives a predetermined command from the first external apparatus, said control unit determines that the first external apparatus is capable of accessing the removable storage medium connected to said third interface unit, and wherein if said second interface unit receives a predetermined command from the second external apparatus, said control unit determines that the second external apparatus is capable of accessing the removable storage medium connected to said third interface unit ([0068]-[0070]).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to RICHARD M. BEMBEN whose telephone number is (571)272-7634. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David L. Ometz/
Supervisory Patent Examiner, Art
Unit 2622

/RMB/